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FITZPATRICK CELLA HARPER & SCINTO			NGUYEN, MADELEINE ANH VINH	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/987,529	<b>Applicant(s)</b> HINO, YASUHIRO
	<b>Examiner</b> Madeleine AV Nguyen	<b>Art Unit</b> 2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### **Status**

1) Responsive to communication(s) filed on 25 April 2008.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1,3,6-8,17,19,22-24,26,28 and 46-49 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,6-8,17,19,22-24,26,28 and 46-49 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/89/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Inventory of Patent Application

6) Other: \_\_\_\_\_



**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 3, 6-8, 17, 19, 20, 22-24, 26, 28 and 46-49 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 6-8, 17, 19, 22-24 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al (US Patent No. 6,029,182) in view of Matsubayashi et al (US Publication No. 2006/0156230).

Concerning claim 1, Nehab discloses a printing system (Fig.1) connected via a network, to an external apparatus storing data (34, Fig.4 or 6) comprising a receiving unit (2, 11, 12, 13, 16, 19 Fig.1 or 2; Fig.9) adapted to receive acquisition information indicating data to be acquired and layout information necessary for assigning an image based on the acquired data to a recording medium having a predetermined size (size of the document, size of a page), the acquisition information and the layout information being input by a user; a sending unit (16, Fig.4) adapted to send the acquisition information and the layout information (URLs, user-defined rules, extraction rules, web commands, structure criteria, content-based criteria, etc.)

received by the receiving unit to the external apparatus (34) via the network so as to cause the external apparatus to acquire the data in accordance with the sent acquisition information and generating printing data; an acquisition unit (17, Fig.6) adapted to acquire the printing data generated by the external apparatus; and a printing unit (7, Fig.1) adapted to print the printing data acquired by the acquisition unit, wherein the external apparatus (34) generates the printing data by formatting, based on the layout information, the data corresponding to the acquisition information from the stored data (Abstract; col. 3, lines 50-64; col. 6, lines 47-50; col. 7, lines 5-10, lines 50-65; col. 8, line 27 – col. 9, lines 45; col. 10, line 60 – col. 11, line 15; col. 11, lines 36-40; col. 11, line 61 – col. 12, line 16; col. 13, line 43 - col. 14, line 35; Appendices 2 and 3).

Nehab does not directly teach that the printing system in Fig.1 is a printer. However, From Fig.3 of the application, the printer 1000 includes formatter controller 1100 which is defined as “not constituted by an actual hardware but by a computer system including a CPU, a ROM, and a RAM etc.” (specification in page 12, lines 17-19). Thus, the printer 1000 includes a formatter controller 1100 which is a computer system. It would have been obvious to one skilled in the art at the time the invention was made to consider the printing system 1 (Fig.1) in Nehab a printer since the printing system 1 also includes a computer system (including a CPU 8, ROM/RAM 14, 5) connected to a network 11a and a printer engine 7 as shown in Fig.3 of the application.

Nehab et al does not directly disclose that the external apparatus generates printing data by formatting based on the layout information and the data corresponding to the acquisition information from the stored data. Matsubayashi et al discloses a system for retrieving and printing network documents comprising a printer (13, Fig.1) connecting to an external apparatus

(web server 14) via a network 12 and to an embedded web server 32. Matsabayashi et al further teaches, “server 14 collects the required data, properly formats the data, and sends the data over Internet 12 to a web browser application...” (paragraph 0046) while the server 14 (Fig.4) discloses, “stored in file storage 49 are documents, either in a printable format ...” (paragraph 0057) wherein the printer 13 can receive the document as, “the document is received in a print-rendered format in step S506.” (paragraph 0063). Thus in the same field of endeavor, Matsabayashi et al discloses that the printer 13 receives the document in a print-ready format (claims 34, 35 in page 5). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of the web server 14 that can generate printing data in a printable format in Matsabayashi et al to the external apparatus in Nehab et al since both of them teach a system for retrieving and printing network documents through network communications.

Concerning claims 3, 6-7, 19, 22-23, Nehab further teaches the acquisition information is represented by URL (44, Fig.9A), (claims 3, 19); the layout information includes information on the recording medium (claim 6) and the layout information is information designating a page and the acquisition unit acquires the printing data corresponding to the designated page (maximum pages, maximum size, formatting rules, extraction specification limits for levels, pages, size, paragraph formatting, style sheets, headers and footers, etc. in Appendices 2 and 3), (col. 9, lines 4-7; col. 9, line 63 – col. 10, line 13; col. 11, lines 12-15; appendices 2 and 3), (claim 7). It is noted that the personal-news-profile-editor 16 and personal-news-profiles 19 can receive input from user to set or change the layout or format including information designating a page or

information on the recording medium as a matter of well known in the prior art (col. 1, lines 18-35) and from the appendices 2 and 3 in Nehab.

Concerning claims 8, 24, Nehab further teaches the data acquired by the external apparatus is described with a structured description language and wherein the structured description language is XML or HTML (18, Fig.2), (claims 8, 24).

Claim 17 is method claim of apparatus claim 1. Claim 17 is rejected for the same rationales set forth for claim 1.

Concerning claim 48, Nehab discloses a printing system (Fig.1) connected via a network, to a Web server holding plural Web pages (35, Fig.4 or 6) comprising a receiving unit (2, 11, 12, 13, 16, 19 Fig.1 or 2; Fig.9) adapted to receive a URL indicating the Web page to be acquired and layout information necessary for assigning an image based on the acquired data to a recording medium having a predetermined size (size of the document, size of a page), the acquisition information and the layout information being input by a user; a sending unit (16, Fig.4) adapted to send the URL and the layout information (user-defined rules, extraction rules, web commands, structure criteria, content-based criteria, etc.) received by the receiving unit to the Web server (35) via the network; an acquisition unit (17, Fig.6) adapted to acquire the printing data generated by the Web server; and a printing unit (7, Fig.1) adapted to print the printing data acquired by the acquisition unit, wherein the Web server (34) generates the printing data by formatting, based on the layout information, the Web page corresponding to the URL from among the plural held Web pages (Abstract; col. 3, lines 50-64; col. 6, lines 47-50; col. 7, lines 5-10, lines 50-65; col. 8, line 27 – col. 9, lines 45; col. 10, line 60 – col. 11, line 15; col. 11,

lines 36-40; col. 11, line 61 – col. 12, line 16; col. 13, line 43 - col. 14, line 35; col. 15, lines 29-39; col. 16, line 21 – col. 17, line 18; col. 18, line 54 – col. 19, line 23; Appendices 2 and 3).

Nehab does not directly teach that the printing system in Fig.1 is a printer. However, From Fig.3 of the application, the printer 1000 includes formatter controller 1100 which is defined as “not constituted by an actual hardware but by a computer system including a CPU, a ROM, and a RAM etc.” (specification in page 12, lines 17-19). Thus, the printer 1000 includes a formatter controller 1100 which is a computer system. It would have been obvious to one skilled in the art at the time the invention was made to consider the printing system 1 (Fig.1) in Nehab a printer since the printing system 1 also includes a computer system (including a CPU 8, ROM/RAM 14, 5) connected to a network 11a and a printer engine 7 as shown in Fig.3 of the application.

Nehab et al does not directly disclose that the Web server 14 generates printing data by formatting based on the layout information and the data corresponding to the acquisition information from the stored data. Matsubayashi et al discloses a system for retrieving and printing network documents comprising a printer (13, Fig.1) connecting to a Web server 14 via a network 12 and to an embedded Web server 32. Matsubayashi et al further teaches, “server 14 collects the required data, properly formats the data, and sends the data over Internet 12 to a web browser application...” (paragraph 0046) while the server 14 (Fig.4) discloses, “stored in file storage 49 are documents, either in a printable format ...” (paragraph 0057) wherein the printer 13 can receive the document as, “the document is received in a print-rendered format in step S506.” (paragraph 0063). Thus in the same field of endeavor, Matsubayashi et al discloses that the printer 13 receives the document in a print-ready format (claims 34, 35 in page 5). It would

have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of the web server 14 that can generate printing data in a printable format in Matsubayashi et al to the external apparatus in Nehab et al since both of them teach a system for retrieving and printing network documents through network communications.

Claim 49 is method claim of apparatus claim 48. Claim 49 is rejected for the same rationales set forth for claim 48.

4. Claims 26, 28, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab in view of Matsubayashi et al (US Publication No. 2006/0156230) and Vidyanand (US Publication No. 2006/0023246).

Concerning claims 26 and 28, Nehab in view of Matsubayashi et al discloses the printing method as disclosed in claim 17 above. Nehab further teaches the step of changing the received layout information (16, Fig.2) (col. 8, lines 12-18; col. 9, line 62 – col. 10, line 13; col. 18, lines 54-64).

Nehab in view of Matsubayashi et al discloses that the received layout information can be changed but does not specifically teach that the changing of the received layout information on the recording medium having a first size to layout information having a second size different from the first size or the information on the recording medium is information indicating a sheet size. However, it was commonly known in the prior art that the layout information of the recording medium can be changed due to different recording medium sizes available for each printer. In the same field of endeavor, Vidyanand supports that prior art by disclosing, “Selected file specific options may be selected paper size (e.g., letter, legal, A4),...” (paragraph 0003), “the

user may also modify a previously defined set 16 ... and save the modified set as a new set 16 (e.g. modifying the selected page size and finishing preferences 18 for "Newsletter 1" and retaining the color preferences for "newsletter 1," and saving the modified set 16 as "proposal 1"), (paragraph 0045). Vidyanand further teaches in Fig.9 the page size selection menu (47a) for selecting different sizes of recording paper. It would have been obvious to one skilled in the art at the time the invention was made to modify the step of changing the layout information from a first recording paper size to a second recording paper size as taught in Vidyanand since Nehab also teaches the changing of the layout and format information without limiting the changing of the paper size.

Concerning claim 46, Nehab in view of Matsubayashi et al further teaches a changing unit (16, Fig.2) adapted to change the layout and format information.

Nehab in view of Matsubayashi et al does not specifically teach that in a case where paper size indicated by the layout information received by the receiving unit is not provided in the printer, the layout information is changed to the layout information indicating a size of paper provided in the printer. However, it was commonly known in the prior art that the layout information of the recording medium can be changed due to different recording medium sizes available for each printer. In the same field of endeavor, Vidyanand supports that prior art by disclosing, "Selected file specific options may be selected paper size (e.g., letter, legal, A4),..." (paragraph 0003), "the user may also modify a previously defined set 16 ... and save the modified set as a new set 16 (e.g. modifying the selected page size and finishing preferences 18 for "Newsletter 1" and retaining the color preferences for "newsletter 1," and saving the modified set 16 as "proposal 1"), (paragraph 0045). Vidyanand further teaches in Fig.9 the page

size selection menu (47a) for selecting different sizes of recording paper. It would have been obvious to one skilled in the art at the time the invention was made to modify the step of changing the layout information from a first recording paper size to a second recording paper size as taught in Vidyanand since Nehab also teaches the changing of the layout and format information without limiting the changing of the paper size.

Claim 47 is method claim of apparatus claim 46. Claim 47 is rejected for the same rationales set forth for claim 46.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Matsuda et al (US Patent No. 7,120,910) discloses a control method for image processing apparatus connectable to computer network.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Madeleine AV Nguyen/  
Primary Examiner, Art Unit 2625

Madeleine AV Nguyen  
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September 17, 2008